| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/707,571 | 11/06/2000 | Michael Patrick Mastro | JSF 35.002 | 9664 |

7590      06/04/2003

Roy L Anderson
Jeffers Shaff & Falk LLp
18881 Von Karman Ave Suite 1400
Irvine, CA   92612

| EXAMINER |
|---|
| ELAHEE, MD S |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2697 | |

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/707,571 | MASTRO, MICHAEL PATRICK |
| | Examiner | Art Unit |
| | Md S Elahee | 2697 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**.     2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-32* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All  b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

# DETAILED ACTION

## *Claim Rejections - 35 USC § 102*

1.     The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.     Claims 1-5, 8-16, 19-25, 31 and 32 are rejected under 35 U.S.C. 102(e) as being

anticipated by Gupton (U.S. Pub. No. 2002/0012426).

Regarding claim 1, Gupton teaches establishing a non-solicitation database of a plurality

of subscriber telephone lines (abstract; page 1, paragraph 0012, page 2, paragraph 0025; 'non-

solicitation database' reads on the claim 'database subscription base').

Gupton further teaches obtaining a calling party number for an incoming call to a selected

phone line of a subscriber in the non-solicitation database (page 2, paragraph 0027; 'number'

reads on the claim 'identification' and 'non-solicitation database' reads on the claim 'database

subscription base').

Gupton further teaches using the calling party number and an application module to

determine whether the incoming call should be connected to the selected phone line (page 2,

paragraph 0027; 'number' reads on the claim 'identification' and 'application module' reads on

the claim 'anti-telemarketing program').

Regarding claim 2, Gupton teaches that the application module queries a solicitor database (page 2, paragraph 0027; 'application module' reads on the claim 'anti-telemarketing program', 'queries' reads on the claim 'accesses' and 'solicitor database' reads on the claim 'telemarketing database').

Regarding claim 3, Gupton teaches that the application module queries the calling party number with the solicitor database containing a plurality of telemarketing telephone numbers to determine if there is a match between the calling party number and any of the plurality of telemarketing telephone numbers and then: if there is no match, completing the incoming call, or if there is a match, blocking the phone call other than completing the call to the selected phone line (fig.2; pages 2, 3, paragraphs 0024, 0027, 0029; 'application module' reads on the claim 'anti-telemarketing program', 'queries' reads on the claim 'compare', 'number' reads on the claim 'identification', 'solicitor database' reads on the claim 'telemarketing database' and 'blocking the phone call' reads on the claim 'taking a preselected action').

Regarding claim 4, Gupton teaches that there is a match, if the calling party number is found in the solicitor database (fig.2; page 2, paragraphs 0024, 0027 0029; 'number' reads on the claim 'identification', 'found' reads on the claim 'matches any number' and 'solicitor database' reads on the claim 'telemarketing database').

Regarding claim 5, Gupton teaches that there is a match, if the calling party number is found in the solicitor database and an override condition is not set (fig.2; page 2, paragraphs 0024, 0027 0029; 'number' reads on the claim 'identification', 'found' reads on the claim 'matches any number' and 'solicitor database' reads on the claim 'telemarketing database').

Regarding claim 8, Gupton teaches that if there is no match, store the calling party number (abstract; pages 3, 4, paragraph 0036; 'store the calling party number' reads on the claim 'keeping a record of the calling party identification').

Gupton further teaches allowing the subscriber to place the incoming call as an unregistered telemarketing telephone number (pages 3, 4, paragraph 0036; 'place the incoming call as an unregistered telemarketing telephone number' reads on the claim 'designate the incoming call as a telemarketing telephone number').

Gupton further teaches placing the telemarketing telephone number in the solicitor database (pages 3, 4, paragraph 0036; 'placing the telemarketing telephone number in the solicitor database' reads on the claim 'adding the calling party identification into the telemarketing database if a preselected criterion for addition is met').

Regarding claim 9, Gupton teaches the preselected criterion which is the calling party number has been designated as a telemarketing telephone number by a preselected number of different subscribers (abstract; pages 3, 4, paragraph 0036; 'number' reads on the claim 'identification').

Regarding claim 10, Gupton teaches the preselected criterion which is a query that the calling party number has been designated as a telemarketing telephone number by a preselected number of different subscribers (page 2, paragraph 0027, pages 3, 4, paragraph 0036; 'query' reads on the claim 'independent verification' and 'number' reads on the claim 'identification').

Regarding claim 11, Gupton teaches that the preselected action is blocking the phone call (fig.2; page 2, paragraph 0027; 'blocking the phone call' reads on the claim 'terminating the incoming call with a call progress tone').

Regarding claim 12, Gupton teaches that the preselected action is providing the incoming call with a notification that the subscriber at the selected telephone line does not accept calls from telemarketers (pages 2, 3, paragraph 0029).

Regarding claim 13, Gupton teaches setting a non-soliciting database for the subscriber (page 3, paragraph 0031; 'non-soliciting database for the subscriber' reads on the claim 'anti-telemarketing flag for the selected telephone line').

Regarding claim 14, Gupton teaches querying a non-soliciting database for the subscriber (page 3, paragraphs 0031, 0032; 'querying a non-soliciting database' reads on the claim 'checking for a set anti-telemarketing flag' and 'subscriber' reads on the claim 'selected telephone line when there is a match').

Regarding claim 15, Gupton teaches setting a non-soliciting database for the telephone terminal and providing the incoming call with a notification that the subscriber at the telephone terminal does not accept calls from telemarketers if the non-soliciting database is not set (page 3, paragraphs 0031, 0032; 'non-soliciting database' reads on the claim 'anti-telemarketing flag' and 'telephone terminal' reads on the claim 'selected telephone line').

Regarding claim 16, Gupton teaches blocking the phone call concerning an improper telemarketing call if the non-soliciting database is set (page 2, paragraph 0027, page 3, paragraphs 0031, 0032; 'blocking the phone call' reads on the claim 'taking a predetermined course of action' and 'non-soliciting database' reads on the claim 'anti-telemarketing flag').

Regarding claim 19, Gupton teaches the solicitor database which is inherently a logical database (page 2, paragraph 0027; 'solicitor database' reads on the claim 'telemarketing database').

Regarding claim 20, Gupton teaches that the incoming call is completed by allowing it to ring through to the telephone terminal (fig.2, step 215; pages 2, 3, paragraph 0029; 'telephone terminal' reads on the claim 'selected telephone line').

Regarding claim 21, Gupton teaches that the application module queries the calling party number with a plurality of telemarketing telephone numbers to determine if there is a match between the calling party number and any of the plurality of soliciting telephone numbers and then: if the calling party number is not treated as a telemarketing identification, completing the incoming call, or if the calling party number is treated as a telemarketing identification, blocking the phone call other than completing the call to the selected phone line (fig.2; pages 2, 3, paragraphs 0024, 0027, 0029; 'application module' reads on the claim 'anti-telemarketing program', 'queries' reads on the claim 'compare', 'number' reads on the claim 'identification', 'plurality of soliciting telephone numbers' reads on the claim 'set of non-telemarketing telephone numbers' and 'blocking the phone call' reads on the claim 'taking a preselected action').

if the calling party identification is not treated as a telemarketing identification, completing the incoming call, or if the calling party identification is treated as a telemarketing identification, taking a preselected action other than completing the call to the selected phone line

Regarding claim 22, Gupton teaches that the solicitor database contains a plurality of soliciting organizations numbers (abstract; page 1, paragraph 0012, page 2, paragraph 0027; 'solicitor database' reads on the claim 'telemarketing database' and 'soliciting organizations numbers' reads on the claim 'non-telemarketing telephone numbers').

Regarding claim 23, Gupton teaches that the application module queries the calling party number with the solicitor database to determine if there is a match between the calling party

number and any of the plurality of soliciting organizations numbers and then: if there is a match,

completing the incoming call, or if there is no match, blocking the phone call other than

completing the call to the selected phone line (fig.2; pages 2, 3, paragraphs 0024, 0027, 0029;

'application module' reads on the claim 'anti-telemarketing program', 'queries' reads on the

claim 'compare', 'number' reads on the claim 'identification', 'solicitor database' reads on the

claim 'telemarketing database', 'soliciting organizations numbers' reads on the claim

'non-telemarketing telephone numbers' and 'blocking the phone call' reads on the claim 'taking

a preselected action').

Regarding claim 24, Gupton teaches a network telephony system (fig.1).

Gupton further teaches a non-solicitation database of a plurality of subscriber telephone

lines connected by the network telephony system (abstract; fig.1; page 1, paragraph 0012, page

2, paragraph 0025; 'non-solicitation database' reads on the claim 'subscription base').

Gupton further teaches a solicitation database (page 2, paragraph 0027; 'solicitor

database' reads on the claim 'telemarketing database').

Gupton further teaches blocking the phone call other than completing a call from one of

the plurality of telemarketing phone lines to one of the plurality of subscriber phone lines when

an incoming call to any of the plurality of subscriber phone lines is identified as being from any

of the plurality of telemarketing phone lines (abstract; pages 2, 3, paragraph 0029, pages 3, 4,

paragraph 0036; 'blocking the phone call' reads on the claim 'a control system that takes a

preselected action').

Regarding claim 25, Gupton teaches that the non-solicitation database includes a plurality

of subscriber telephone lines (fig.1; page 1, paragraph 0012, page 2, paragraph 0025; 'non-

solicitation database' reads on the claim 'subscription base' and 'a plurality of subscriber telephone lines' reads on the claim 'subscriber phone lines from at least two area codes').

Regarding claim 31, Gupton teaches that the network telephony system is a public switched telephone network (fig.1).

Regarding claim 32, Gupton teaches a non-solicitation database of a plurality of subscriber telephone lines (abstract; fig.1; page 1, paragraph 0012, page 2, paragraph 0025; 'non-solicitation database' reads on the claim 'subscription base').

Gupton further teaches a solicitation database containing a plurality of telemarketing telephone numbers (page 2, paragraph 0027; 'solicitor database' reads on the claim 'logical telemarketing database' and 'telephone numbers' reads on the claim 'phone lines').

Gupton further teaches that an application module allows a subscriber to identify a calling party number as a telemarketing telephone number (page 3, paragraph 0033; 'application module' reads on the claim 'subscriber telemarketing identification mechanism' and 'calling party number as a telemarketing telephone number' reads on the claim 'calling party identification as a potential telemarketing phone line').

Gupton further teaches that an application module can place the telemarketing telephone number in the solicitor database (pages 3, 4, paragraph 0036; 'application module' reads on the claim 'subscriber telemarketing identification mechanism' and 'place the telemarketing telephone number in the solicitor database' reads on the claim 'add an identified potential telemarketing phone line to the logical telemarketing database as one of the plurality of telemarketing phone lines if a preselected criterion for addition is met').

Gupton further teaches blocking the phone call other than completing a call from one of

the plurality of telemarketing phone lines to one of the plurality of subscriber phone lines when

the call is identified as originating from one of the plurality of telemarketing phone lines

(abstract; pages 2, 3, paragraph 0029, pages 3, 4, paragraph 0036; 'blocking the phone call' reads

on the claim 'a control system that takes a preselected action').

### *Claim Rejections - 35 USC § 103*

3.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.      Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupton (U.S. Pub.

No. 2002/0012426) and in view of Metcalf (U.S. Pub. No. 2002/0085700).

Regarding claims 6, Gupton fails to teach "the override condition is set if the calling party

identification matches an excluded telemarketing telephone number". Metcalf teaches that the

override condition is set if the call-initiator is attempted to be disable (page 5, paragraph 0043;

'call-initiator is attempted to be disable' reads on the claim 'calling party identification matches

an excluded telemarketing telephone number'). Thus, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify Gupton to allow the

override condition being set if the calling party identification matches an excluded telemarketing

telephone number as taught by Metcalf. The motivation for the modification is to have the

override condition in order to complete the call being blocked if there is any legal reason.

5.      Claims 7, 17, 18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gupton (U.S. Pub. No. 2002/0012426) and in view of Wurster et al. (U.S. Patent No. 6,459,780).

Regarding claim 7, Gupton fails to teach "a party other than the subscriber can set the

override condition". Wurster teaches that a caller can enter a call screening override code (col.7,

lines 64, 65; 'caller' reads on the claim 'party other than the subscriber' and 'enter a call

screening override code' reads on the claim 'set the override condition'). Thus, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to modify

Gupton to allow a party other than the subscriber to set the override condition as taught by

Wurster. The motivation for the modification is to have doing so in order to connect the caller to

the called party.

Regarding claim 17, Gupton teaches that allowing the subscriber to access a customized

subscriber database via a computer and wherein the customized subscriber database is generated,

at least in part, from the solicitor database (page 2, paragraph 0027, pages 3, 4, paragraph 0036;

'solicitor database' reads on the claim 'telemarketing database',).

Gupton fails to teach "selectively vary one or more override conditions for at least one

telephone number contained within the customized subscriber database". Wurster teaches that

selectively vary a call screening override code for at least one telephone number contained

within the customized subscriber database (col.5, lines 43-46, col.6, lines 45-54, col.7, lines 64-

67, col.8, lines 1-9; 'a call screening override code' reads on the claim 'one or more override

conditions'). Thus, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Gupton to selectively vary one or more override conditions for at

least one telephone number as taught by Wurster. The motivation for the modification is to have doing so in order to connect the caller to the called party.

Regarding claim 18, Gupton fails to teach "the subscriber is allowed to selectively vary an override condition for a selected group of telephone numbers contained within the customized subscriber database". Wurster teaches that the subscriber is allowed to selectively vary an override condition for a selected group of telephone numbers contained within the customized subscriber database (col.5, lines 43-46; col.6, lines 45-54, col.7, lines 64-67, col.8, lines 1-9; 'a call screening override code' reads on the claim 'one or more override conditions'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gupton to selectively vary an override condition for a selected group of telephone numbers as taught by Wurster. The motivation for the modification is to have doing so in order to connect the caller to the called party whenever required.

Regarding claim 26, Gupton teaches that an application module allows one or more of the plurality of telemarketing phone lines to complete a call with one or more of the plurality of subscriber phone lines (page 3, paragraph 0033; 'application module' reads on the claim 'control system override'). However, Gupton fails to teach to set an override condition. Wurster teaches to enter a call screening override code (col.7, lines 64, 65; 'enter a call screening override code' reads on the claim 'set an override condition'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gupton to allow a party other than the subscriber to set the override condition as taught by Wurster. The motivation for the modification is to have doing so in order to connect the caller to the called party.

6.      Claims 27, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gupton (U.S. Pub. No. 2002/0012426) and in view of Wurster et al. (U.S. Patent No. 6,459,780)

and further in view of Garfinkel (U.S. Patent No. 6,330,317).

Regarding claim 27, Gupton in view of Wurster fails to teach "the override condition can

be set by a subscriber". Garfinkel teaches that the override condition can be set by a customer

(col.7, lines 36-54; 'customer' reads on the claim 'subscriber'). Thus, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify Gupton

in view of Wurster to allow a party other than the subscriber to set the override condition as

taught by Garfinkel. The motivation for the modification is to have doing so in order to connect

the caller to the called party in case of necessity.

Regarding claim 28, Gupton in view of Wurster fails to teach "the subscriber can set the

override condition by using a computer to access a customized subscriber database". Garfinkel

teaches that the customer can set the override condition by using a computer to access a updated

override list (col.7, lines 36-54; 'customer' reads on the claim 'subscriber' and 'updated override

list' reads on the claim 'customized subscriber database'). Thus, it would have been obvious to

one of ordinary skill in the art at the time the invention was made to modify Gupton in view of

Wurster to selectively vary an override condition for a selected group of telephone numbers as

taught by Garfinkel. The motivation for the modification is to have doing so in order to connect

the caller to the called party whenever required.

Regarding claim 30, Gupton teaches that an application module allows a subscriber to

identify a calling party number as a telemarketing telephone number (page 3, paragraph 0033;

'application module' reads on the claim 'subscriber telemarketing identification mechanism' and

'calling party number as a telemarketing telephone number' reads on the claim 'calling party identification as a potential telemarketing phone line').

Gupton further teaches that an application module can find the telemarketing telephone number in the solicitor database (pages 3, 4, paragraph 0036; 'application module' reads on the claim 'telemarketing identification logic' and 'find the telemarketing telephone number in the solicitor database' reads on the claim 'identifies the potential telemarketing phone line to the logical telemarketing database as one of the plurality of telemarketing phone lines if a preselected criterion is met').

7.      Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupton (U.S. Pub. No. 2002/0012426) and in view of Wurster et al. (U.S. Patent No. 6,459,780) and further in view of Pines et al. (U.S. Pub. No. 2003/0007625).

Regarding claim 29, Gupton in view of Wurster fails to teach "the override condition can be set by a third party". Pines teaches that the override condition can be set by a third party (page 11, paragraph 0145; 'customer' reads on the claim 'subscriber'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gupton in view of Wurster to allow the override condition to be set by a third party as taught by Pines. The motivation for the modification is to have doing so in order to make a connection between the caller and the called party.
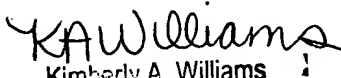
## *Conclusion*

8.      Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alam Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on (703)305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Kimberly A. Williams
Primary Examiner
Technology Center 2600

M.E.
MD SHAFIUL ALAM ELAHEE
May 27, 2003